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AMENDMENT UNDER 37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
GROUP 2742  
PATENT APPLICATION

AF/2742  
#10/Request for reconsideration  
4-18-01  
A.T.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Manabu DEGUCHI

Appln. No.: 09/192,303

Confirmation No.: Not assigned

Group Art Unit: 2742

Filed: November 17, 1998

Examiner: CHIANG, J

For: PORTABLE COMMUNICATION APPARATUS

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AMENDMENT UNDER 37 C.F.R. § 1.116

ATTN: BOX AF  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action dated January 17, 2001, Applicant respectfully requests reconsideration in view for the following Remarks. Claims 1-30 are pending in the present application.

Applicant acknowledges with appreciation the withdrawal of the previous grounds of rejection of claims 1-13 under 35 U.S.C. §102 for alleged anticipation by Grisham and the 35 U.S.C. § 103(a) rejection for alleged obviousness over JP6-232992 in view of Grisham. However, Applicant respectfully requests withdrawal of the rejection based on the new prior art grounds.

**I. Claims 1, 4, 9, 21-23 and 24-30 are novel**

Claims 1, 4, 9, 21-23 and 24-30 stand rejected under 35 U.S.C. §102 as being allegedly anticipated by Macor (U.S. Patent No. 5,901,222). Applicant respectfully submits that Macor fails to disclose all of the features recited in the rejected claims, as required under §102. Accordingly, Applicant respectfully requests withdrawal of the rejection.

Macor discloses a user interface for portable telephones. As illustrated in Figure 2 of Macor, a first user interface 8 and a second user interface 20 are provided, as well as an input device 22 (i.e., a trackball). However, the input device does not have a first portion and a second portion in any of the figures of Macor, and the trackball is not a key section. Further, Applicant respectfully submits that Macor discloses navigation and selection of an item with the trackball, but does not disclose executing a task. For example, the trackball of Macor can select a function key, but is not capable of executing a task.

Applicant respectfully submits that Macor fails to disclose all of the features recited in claims 1, 14 and 24. For example and not by way of limitation, Macor fails to disclose an input device having a first portion and a second portion, as recited in claim 14. Applicant respectfully submits that the input device 22 of Macor only has a single portion, and thus does not disclose any second portion. Further, Applicant respectfully submits that Macor fails to disclose that the first portion executes a task in accordance with said selected item, as recited in claims 14 and 24.

Additionally, Applicant respectfully submits that Macor fails to disclose a key section, as recited in claim 1. As noted above, Macor discloses an input device 22, which is different from a key section, as recited in claim 1.

Claim 4 depends from claim 1, claim 17 depends from claim 14, and claims 25-30 depend from claim 24. Applicant respectfully submits that the dependent claims are allowable for at least the same reasons as the claims from which they depend. Further, Applicant respectfully submits that Macor does not disclose all of the features recited in claim 9, because as admitted by the Examiner, Macor does not disclose all of the features recited in claim 6, from which claim 9 depends. Accordingly, Applicant respectfully requests withdrawal of the rejections under §102.

**II. Claims 2-3, 5-8, 10-13, 15-16, and 18-20 would not be obvious**

**A. Claims 6-7, 10-11 and 13 would not be obvious**

Claims 6-7, 10-11 and 13 stand rejected under 35 U.S.C. § 103(a) as being obvious over Macor in view of Japanese Patent Publication 06-90200 (hereafter "JP '200"). Applicant respectfully submits that the Examiner's proposed combination fails to disclose or suggest the claimed combination of the features recited in the rejected claims. Accordingly, Applicant respectfully requests withdrawal of the rejection under §103(a).

JP '200 discloses a portable radio telephone set have a dial 8 that is a volume control in a radio call state and a keypad 13. When the device of JP '200 is not in a radio call state, the dial 8 can select every kind of set. However, JP '200 does not disclose that the dial 8 is capable of executing a task (or a selected information item) from a plurality of information items displayed in a display.

Applicant respectfully submits that the Examiner's proposed combination fails to disclose or suggest the claimed combination which includes, inter alia, a first key section comprising a plurality of key contacts which are used to select a desired information item from a plurality of

information items displayed in the display and then to execute a selected information item, and a second key section that comprises a ten-key pad. Applicant respectfully submits that while JP '200 discloses a keypad, the dial 8, which the Examiner asserts is the first key section, does not disclose or suggest a plurality of key contacts used to select a desired information item from a plurality of information items, as recited in claim 10, as one would not use a volume control in a radio call state to select a telephone number and make a telephone call. Applicant respectfully submits that one of ordinary skill in the art would not be motivated to use the volume control dial 8 as the first key section as recited in claim 10.

Additionally, Applicant respectfully submits that the Examiner's proposed combination fails to disclose or suggest the claimed combination, which includes, inter alia, executing a selected information item, as recited in claim 6. As noted above, Macor does not execute a selected item, and Applicant respectfully submits that the combination of JP '200 into Macor fails to cure this deficiency, because as noted above, the volume control 8 does not select anything from information displayed in a display when in a radio call state, as recited in claim 6, and further, the keypad 13 is also not disclosed to select a desired information item from a display.

Claim 7 depend from claim 6 and claims 11 and 13 depend from claim 10, and those claims are allowable for at least the same reason as the independent claims from which they depend. Accordingly, Applicant respectfully requests withdrawal of the rejections of claims 6-7, 10-11 and 13 under §103(a).

**B. Claims 18-20 would not be obvious**

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Claims 18-20 stand rejected under 35 U.S.C. § 103(a) for alleged obviousness over Macor in view of Brandenburg (U.S. Patent No. 5,231,386). Applicant respectfully submits that the Examiner's proposed combination fails to disclose or suggest all of the features recited in claims 18-20.

Brandenburg discloses keyswitch-integrated pointing assembly. More specifically, Brandenburg discloses a single contact 32 with a dome spring 21, but does not disclose the claimed combination that includes a second contact.

Claims 18-20 depend from claim 14, and are allowable for at least the same reasons as discussed above with respect to claim 14. Additionally, the Examiner's proposed combination fails to disclose a second contact to execute said task, as recited in claim 19.

**C. Claims 2-3, 5, 8, 12 and 15-16 would not be obvious**

Claims 2-3, 5, 8, 12 and 15-16 stand rejected under 35 U.S.C. § 103(a) over Ishida (U.S. Patent No. 4,511,102). Applicant respectfully submits that the Examiner's proposed combination fails to disclose or suggest the claimed combination of the features recited in the rejected claims. Accordingly, Applicant respectfully requests withdrawal of the rejection under §103(a).

Ishida discloses a switching device for rear view mirrors of an automotive vehicle. Ishida includes a switch knob 22b, which allows a user to switch between mirrors to be controlled. Applicant respectfully submits that Ishida discloses a controller for adjusting windows having a execution key that selects between windows rather than executing.

Applicant respectfully submits that the Examiner's proposed combination fails to disclose or suggest the claimed combination of the features recited in the claims. For example, the Examiner's proposed combination fails to disclose or suggest an execution key that executes the

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selected information item, as recited in claims 2, 8 and 12. Further, Applicant respectfully submits that the Examiner's proposed combination fails to disclose or suggest the execution key spaced apart from the other operation keys of the keypad, as recited in claims 3 and 5.

Claims 15-16 depend from claim 14, and would not be obvious for at least the same reasons as claim 14. Accordingly, Applicant respectfully requests withdrawal of the rejections under §103(a).

### **III. Conclusion**

Reconsideration and allowance of all claims are respectfully requested in view of the following remarks. In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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